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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/671,011	09/25/2003	Morten Eriksen	43708.15.1	4541

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INTELLECTUAL PROPERTY GROUP  
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MINNEAPOLIS, MN 55402

EXAMINER
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NATNITHADHA, NAVIN

ART UNIT	PAPER NUMBER
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3735

MAIL DATE	DELIVERY MODE
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07/16/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/671,011

Applicant(s)

ERIKSEN ET AL.

Examiner

Navin Natnithithadha

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 25 April 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 19-68 is/are pending in the application.
- 4a) Of the above claim(s) 19-40 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 41-68 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 20040818;20040823;20050919.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Response to Amendment***

1. Claims 19-40 have been withdrawn. Claims 1-18 have been cancelled. Claims 41-68 have been added. Claims 1-68 are pending.

### ***Election/Restrictions***

2. Claims 19-40 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 25 April 2007.

Applicant's election with traverse of Group I, claims 1-18, in the reply filed on 25 April 2007 is acknowledged. In the Amendment filed on 25 April 2007, Applicant cancelled claims 1-18 and added claims 40-68 that changed the limitations directed to a device for measuring the movement of an object from that of the original claims 1-18. The traversal is on the ground(s) that "the subject matter of Groups I, II, and III are sufficiently related that a thorough search for the subject matter of one Group would encompass a search for the subject matter of the other Group." See Applicant's Remarks, filed 25 April 2007, p. 2. This is not found persuasive because Group II is structurally distinct from the structure of amended Group I (apparatus claims 41-55), and Group II contains process steps distinct from the steps of amended Group I (method claims 56-68). In addition, amended Group I is directed to a device for

measuring movement, whereas Group II is directed to a device for measuring the signals corresponding to the values of area or volume of an object within a homogenous magnetic field and Group II is directed to a method of measuring the area or volume of an object. It would be burdensome to exam all three groups because the groups require separate considerations with respect to the prior art, as shown by the subject matter the groups are directed to.

The requirement is still deemed proper and is therefore made FINAL. A complete reply to this Office Action must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

### ***Information Disclosure Statement***

3. The information disclosure statement filed 23 August 2004 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each cited foreign patent document; each non-patent literature publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 41-68 are rejected under 35 U.S.C. 102(b) as being anticipated by Goldberg et al, US 3,731,184 A ("Goldberg").

Claims 41-55: Goldberg teaches a device for measuring the movement of an object ("measure cross-sectional areas and area changes and rates of change, and other quantities which can be made to correspond to such areas and area changes," see col. 6, ll. 27-31, and col. 7, ll. 52-60):

first 10 and second 11 matched pairs of fixed coils;

a patient coil ("pick-up coil") 12 configured to wrap elastically around a patient's body part;

a current source ("field supply") 13 coupled to, and adapted to energize, either the matched pairs 10 and 11 of fixed coils or the patient coil 12; and

a volume sensing element 12 comprising whichever of the matched pairs of fixed coils or the patient coil 12 that is not coupled to the current source 13;

whereby the first 10 and second 11 matched pairs of fixed coils are arranged to reduce a sum of magnetic noise signals from remote sources to zero and to generate a relatively homogeneous magnetic field in a spatial volume occupied by the patient's

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body part ("use of a coil with small and flattened diameter minimizes [measurement] error," see col. 9, ll. 24-40).

Additionally, Goldberg teaches a variety of apparatus configurations and orientations including the coil 12 having "n" number of turns (see col. 8, ll. 5-68). Thus, claims 42-55 are within the scope of Goldberg's invention.

Claims 56-68: Because the subject matter of method claims 56-68 is not distinct from apparatus claims 41-55, the claimed method is anticipated by Goldberg for the same reasons discussed above.

### ***Conclusion***

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Navin Natnithithadha whose telephone number is (571) 272-4732. The examiner can normally be reached on Monday-Friday, 8:00-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles Marmor, II, can be reached on (571) 272-4730. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Navin Natnithithadha  
Patent Examiner  
Art Unit 3735  
07/09/2007